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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,437	02/25/2004	Robert Tigner	0563JB.036284	4878

7590 03/21/2007
Attention: James E. Bradley
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 61389
Houston, TX 77208-1389

EXAMINER

FORD, JOHN K

ART UNIT	PAPER NUMBER
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3744

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No.		Applicant(s)	
	10/786,437		TIGNER ET AL.	
	Examiner		Art Unit	
	John K. Ford		3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/22/07
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Applicant's response of February 22, 2007 has been carefully considers. It raises a number of new issues that are addressed in the rejections that follow. Further discussion of the original rejections is deemed moot in light of the newly claimed subject matter.

Applicant has previously identified claims 1-7, 10 and 11 as readable on the elected species of Figures 1 and 3 as shown within elected Group I. Claim 11 was cancelled in the February 22, 2007 amendment. Accordingly, claims 1-7 and 10 are addressed here.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1 and 10 applicant claims that the oil filter is "free from attachment to" the engine and also claims in those same claims that the oil filter is attached to the engine by two "fluid lines" that extend between the oil filter and the engine. The fact that claims 1 and 10 have these two contradictory limitations makes it

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ambiguous as to what applicant is really claiming. Likewise, the dependent claims 2-7 are ambiguous for the same reason.

An independent problem also exists with respect to claims 2, 5, and 7. In those claims, repeated reference is made to "the pump", however the pump recitation in question has been deleted from claim 1. Again, it is ambiguous whether or not the pump is part of the claimed combination. In giving the claims their broadest reasonable interpretation, it is unclear what weight, if any, is to be given to the limitations of claims 2, 5 and 7 when the pump is not even part of the claimed combination as defined in claim 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 5, 6, 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Wakabayashi et al (USP 4,748,824) and Carter et al (USP 3,295,507) and either one of DeGrazia, Jr. (USP 4,676,206) or Batrice (USP 5,074,379).

Wakabayashi discloses an auxiliary engine 35 and electrical generating device 33 mounted on a skid common mount 30. The common mount 30 permits the engine

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and generator to be removed from the housing 1 as a unit. See the abstract and the detailed portion of the specification, both incorporated here by reference. The housing 1 is adapted to be mounted on the front wall of a trailer, an exterior portion of a vehicle (see, Figures 5 and 6 of Wakabayashi). No electrical motor driving a lubricant pump attached to a filter is shown connected to auxiliary engine 35.

Carter teaches a lubricant pump 24, driven by an electric motor 26, mounted exteriorly of an engine 10. The electric motor 26 is powered by battery 28 and, conventionally, generator 42 recharges battery 28, as is well known to those of ordinary skill in this art, official notice being taken of this well-known fact. Since applicant did not seasonably challenge this subject of official notice in the February 22, 2007 response, it is established as fact in this prosecution. A lubricant filter 20 is located, fluidly, between the pump 24 and the engine 10 and operates as described in column 5, lines 41-57, that explanation being incorporated here by reference. The advantage to this type of external oil recirculation system is that it prolongs the life of the engine.

To have added a lubricant pump 24 driven by an electric motor 26 (and associated electrical circuitry 30, 32 and 42) and the lubricant filter 20 of Carter to the engine 35 of Wakabayashi to improve service life of engine 35 of Wakabayashi would have been obvious to one of ordinary skill in the art. As shown in Figure 16 of Wakabayashi, generator 33 recharges battery 36, in the manner discussed above in

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reference to Carter. In making this modification, Carter's circuitry, at 30 would be connected to battery 36 of Wakabayashi.

Regarding claim 2, see electric motor 26 of Carter. Regarding claims 3, 4 and 10, see skid 30 of Wakabayashi. Regarding claim 5, generator 42 in Carter generates DC electricity, as does generator controller 12 in Wakabayashi. Regarding claim 6 and 11, generator 33 of Wakabayashi is an AC generator and generator 42 of Carter is a DC generator. To have used a DC generator in Wakabayashi (as taught by Carter at 42) in addition to AC generator 33, to advantageously avoid having to use a generator controller 12 to rectify and reduce the AC output of generator 33 from 460 Volts AC to 12 Volts DC would have been obvious to one of ordinary skill in the art. While Carter is silent as to whether generator 42 is an alternator-type generator (e.g. alternator with a diode-bridge or slip-rings) alternator-type generators are extremely well known and official notice is taken here. Since applicant did not seasonably challenge this subject of official notice in the February 22, 2007 response, it is established as fact in this prosecution, but, if necessary, see Lace USP 3,614,593, second full paragraph in column 1, incorporated here by reference, relied upon here ONLY to show common knowledge to those of ordinary skill in this art. Regarding claim 7, the DC generator 42 (which could be an alternator-type DC generator, as discussed in regard to claim 6) in Carter recharges the battery 28 and that in turn powers electric motor 26 which drives pump 24.

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Either one of DeGrazia, Jr. (USP 4,676,206, Figures 1-2) or Batrice (USP 5,074,379, Figures 8-10) teach the relocation of the engine oil filter away from the engine onto the wall of the engine enclosure to advantageously aid in changing the filter by locating it in a more accessible place for the service person. To have screwed the adaptor 21 of DeGrazia or the adaptor of Figure 9 of Batrice to element 50 of Carter so as to permit the remote location of the oil filter by the associated flexible fluid lines (23 of DeGrazia and 210, 212 of Batrice) to a location within the engine compartment away from the engine would have been obvious to advantageously permit easier replacement of the oil filter.

Claims 1, 3, 4, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Wakabayashi et al (USP 4,748,824) and either one of DeGrazia, Jr. (USP 4,676,206) or Batrice (USP 5,074,379).

Wakabayashi discloses an auxiliary engine 35 and electrical generating device 33 mounted on a skid common mount 30. The common mount 30 permits the engine and generator to be removed from the housing 1 as a unit. See the abstract and the detailed portion of the specification, both incorporated here by reference. The housing 1 is adapted to be mounted on the front wall of a trailer, an exterior portion of a vehicle (see, Figures 5 and 6 of Wakabayashi). No remotely located oil filter is shown connected to auxiliary engine 35. Regarding claims 3, 4 and 10, see skid 30 of

Wakabayashi. Regarding claim 6 element 33 of Wakabayashi generates AC electricity and element 12 generates DC electricity.

Either one of DeGrazia, Jr. (USP 4,676,206, Figures 1-2) or Batrice (USP 5,074,379, Figures 8-10) teach the relocation of the engine oil filter away from the engine onto the wall of the engine enclosure to advantageously aid in changing the filter by locating it in a more accessible place for the service person. To have used the system disclosed in Figures 1-2 (elements 21-24) of DeGrazia or the system of Figures 8-10 of Batrice to filter the oil in the engine 35 of Wakabayashi in a location within the engine compartment of Wakabayashi away from the engine 35 would have been obvious to advantageously permit easier replacement of the oil filter. The fact that the Wakabayashi disclosure lacks any mention of engine 35 having an oil filter is deemed to be because of the conventionality of such filters. All modern engines of greater than lawn mower size that the examiner is aware of have oil filters. The omission of one in the disclosure of Wakabayashi is deemed to be because of the conventionality of oil filters on engines and the fact that the oil filter forms no part of the invention of Wakabayashi.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note Mellum, USP 5,333,678, Figures 2 and 3 and col. 3, lines 34-37, incorporated here by reference.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JKF



John K. Ford
Primary Examiner